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SEP 05 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Charles G. Heisinger, Jr.
For : METHOD AND SYSTEM FOR
: TELEPHONICALLY SELECTING,
: ADDRESSING, AND DISTRIBUTING
: MESSAGES
Serial No.: 09/545,088
Filed : April 7, 2000
Art Unit : 2162
Examiner : Jean B. Fleurantin
Att. Docket : CGH 3001
Confirmation No. : 1969

REPLY BRIEF

Mail Stop: Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answer mailed July 3, 2006.

I. WITHDRAWAL OF REJECTIONS

In section 6, entitled "Grounds of Rejection to be Reviewed on Appeal", on page 2, the Examiner's Answer withdraws the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112. The Grounds of Rejections to be Reviewed on Appeal section 6 also asserts that the Appellant's statement of the Grounds of Rejection to be Reviewed on Appeal is not correct. However, the

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Grounds of Rejection to be Reviewed on Appeal section 6 of the Examiner's Answer makes no affirmative statement of the grounds of rejection to be reviewed on appeal.

For at least the foregoing reasons, Appellant respectfully submits that section 9 of the Examiner's Answer, entitled "Grounds of Rejection" should be treated as a thorough statement of the grounds of rejection to be reviewed on appeal. More specifically, section 9 of the Examiner's Answer on pages 3 and 4 of the Examiner's Answer details one rejection, and only one rejection, of the pending claims. Specifically, section 9 on pages 3 and 4 of the Examiner's Answer details a rejection of claims 36-40, 44 and 57-64 as being allegedly unpatentable over U.S. Patent No. 5,884,032 to Bateman, et al. (hereinafter "Bateman") in view of U.S. Patent No. 5,913,210 to Call.

For at least the foregoing reasons, Appellant respectfully submits that claims 47-56 should be treated as no longer being subject to a rejection. More specifically, Appellant respectfully submits that the rejection of claims 47-56 as allegedly being unpatentable over Bateman in view of Call and further in view of Appellant's allegedly admitted prior art contained in section 8 on pages 8-10 of the Office Action mailed August 2, 2004, should be treated as withdrawn along with the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112 also expressly withdrawn by the Examiner's Answer.

Alternatively, if the Board intends to retreat the rejections of claims 47-56 as being allegedly unpatentable over Bateman in view of Call and further in view of Appellant's allegedly admitted prior art as being an existing and outstanding rejection for review on appeal, then Appellant respectfully requests that the Examiner's Answer be rejected as non-compliant. The Examiner's Answer does not afford the Appellant an opportunity to understand the Examiner's position on

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Appeal with respect to the rejection of claims 47-56, if that rejection is in fact maintained, as Appellant is permitted to do. This request is discussed further below in connection with the last paragraph on page 7 and all of page 8 of the Examiner's Answer.

II. CHANGE IN REJECTION OF CLAIMS 36-40, 44 and 57-64

In the final paragraph on page 4, at lines 5-12, the Examiner's Answer sets forth a newly alleged motivation for combining the respective teachings of Bateman and Call in the rejection of claims 36-40, 44, and 57-64. However, the Examiner's newly asserted motivation for combining the teachings of these two references suffers from the very same deficiencies that existed in the Examiner's previously alleged motivation for combining these references.

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art.

Citation. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998)

The recharacterized motivation to combine the disclosure of Call and Bateman described at page 4 of the Examiner's Answer in the fifth full paragraph at lines 5-12 is repeated *verbatim* in the paragraph bridging pages 6 and 7 of the Examiner's Answer at lines 8-15. This newly characterized motivation to combine the teachings of Call and Bateman will be specifically

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addressed below in connection with the paragraph bridging pages 6 and 7 of the Examiner's Answer.

A. Suggestion Or Motivation To Combine In The Prior Art

The August 2, 2004 Office Action does not assert that a suggestion or motivation to combine the disclosure of Bateman with the disclosure of Call can be found in the prior art. The changed rejection of claims 36-40, 44 and 57-64 contained in the Examiner's Answer attempts to assert that a suggestion or motivation to combine the disclosure of Bateman with the disclosure of Call can be found in the prior art. However, this assertion is deficient. This will be described in greater detail below in connection with the repeated statement of the newly asserted motivation to combine the disclosure of Bateman with the disclosure of Call contained in the paragraph bridging pages 6 and 7 of the Examiner's Answer.

B. Suggestion Or Motivation To Combine In
The Nature Of The Problem To Be Solved

Neither the final rejection nor the changed rejection of the claims in the Examiner's Answer asserts that a suggestion or motivation to combine the disclosure of Bateman and Call arises from the nature of the problem to be solved.

C. Suggestion Or Motivation To Combine In The
Knowledge Of One Of Ordinary Skill In The Art

The change in the rejection of claims in the Examiner's Answer appears to add a new argument that a suggestion or motivation to combine the disclosure of Bateman and Call can be found in the knowledge of one of ordinary skill in the art. However, the alleged motivation to combine has failed to satisfy the burden described above. A rejection under on 35 U.S.C.

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§103(a) must be based on a facts and include a showing of a suggestion, teaching or *motivation* to combine the prior art references. The foregoing allegations are prime examples of impermissible hindsight reasoning. This will be discussed in greater detail below in connection with the paragraph bridging pages 6 and 7 of the Examiner's Answer.

III. RESPONSE TO APPELLANT'S ARGUMENTS

In section (10) entitled "Response to Argument", the Examiner's Answer puts forth several new arguments in response to Appellant's Appeal Brief. Appellant will respond to each of the Examiner's new arguments in turn. However, Appellant first notes that the Examiner's Answer does not respond to one or more arguments contained in Appellant's Brief. On this basis alone the rejections should be overturned.

A. The Final Two Paragraphs on Page 5 of the Examiner's Answer

In the final two paragraphs on page 5 of the Examiner's Answer, the Examiner provides a responsive argument and cites Call col. 9, lines 26-32 in support of that responsive argument. Col. 9, lines 26-32 of Call describe dynamically creating a product description. In contradistinction, claim 36 recites a method of addressing an electronic message including retrieving a product description that already exists. Consequently, the disclosure, teaching and suggestion newly cited by the Examiner's Answer, Call, col. 9, lines 26-32 does not disclose, teach or suggest the subject matter recited in the rejected claims as alleged by the Examiner.

B. The Paragraph Bridging Pages 6 and 7 of The Examiner's Answer

Lines 8-15 of the paragraph bridging pages 6 and 7 of the Examiner's answer repeat *verbatim* the recharacterized motivation to combine the respective teachings of Bateman and Call

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newly added to the rejection by the Examiner's Answer, citing Call, col. 1, lines 32-35 for the motivation to facilitate the transfer of information about products. However, the motivation to simply facilitate the transfer of information about products, in the absence of a disclosure, teaching or suggestion of how to accomplish that goal, begs the questions of how the goal is achieved.

Thus, in the first two lines on page 7 of the Examiner's Answer, the Examiner adds alleged motivation to combine the respective teachings of Bateman and Call that is not included in the recharacterized motivation newly added to the Examiner's Answer on page 4, fifth full paragraph, lines 5-12. Further, the additional motivation to combine the respective teachings of Bateman and Call alleged on page 7, lines 1-2 of the Examiner's Answer is not found in any of the applied references.

Rather, the motivation to combine the respective teachings of Bateman and Call alleged at page 7, lines 1-2 of the Examiner's Answer appears to have come only from the mind of the Examiner based on impermissible hindsight reasoning having the benefit of the knowledge of the inventive combinations recited in the rejected claims. The Examiner does not allege that this motivation is derived from the prior art itself, and in fact the motivation is not found in the prior art. The Examiner does not allege that the motivation is found in the nature of the problem to be solved, and the Examiner does not allege that the motivation is found in the knowledge of one of ordinary skill in the art. Rather, the motivation to combine the respective teachings of Bateman and Call alleged at page 7, lines 1-2 of the Examiner's Answer is a prime example of impermissible hindsight reasoning.

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C. The Last Paragraph on Page 7 and Page 8
of the Examiner's Answer

As described in greater detail above, claims 47-56 are not subject to any rejection in the grounds of rejection to be reviewed on appeal acknowledged by the Examiner's Answer. Therefore, Appellant is puzzled by the inclusion of an argument by the Examiner that pertains to claims 47-56.

As stated in greater detail above, Appellant respectfully requests that the Board treat claims 47-56 as not being subject to any outstanding rejection. Alternatively, as stated in greater detail above, Appellant respectfully requests that the Board reject the Examiner's Answer as non-compliant and thus afford the Appellant an opportunity to fully and properly evaluate the Examiner's current position with respect to the rejection of claims 47-56, if such a rejection still exists. In the event that the Board denies both of the alternative requests respectfully made by Appellant as described above, Appellant responds to the last paragraph on page 7 and page 8 of the Examiner's Answer as follows.

The Examiner continues to treat portions of the specification as admitted prior art. Thus, the Examiner concedes the deficiency of the combination of Bateman and Call with respect to claims 47-56. However, the Examiner completely ignores Appellant's assertion that no admission has been made that the disclosure and specification relied upon by the Examiner is statutory prior art under 35 U.S.C. § 102. Further, a broad interpretation of claims 47-56 (see the first two full paragraphs on page 8 of the Examiner's Answer) is irrelevant to the issue of

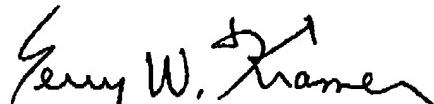
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whether Appellant has admitted that the disclosure in Appellant's specification relied upon by the Examiner is statutory prior art under 35 U.S.C. § 102.

It is respectfully submitted that the remaining points of argument set forth in the Examiner's Answer are repetitive, and thus were fully addressed in Appellant's Appeal Brief. For the reasons set forth herein and in the Appeal Brief, it is respectfully requested that the rejections of the claims under 35 U.S.C. §103(a) be reversed.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.



Terry W. Kramer
Registration No.: 41,541

Date: September 5, 2006

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FROM: Terry W. Kramer
KRAMER & AMADO, P.C.

DATE: September 5, 2006

SUBJECT: U.S. Patent Application
Title: METHOD AND SYSTEM FOR TELEPHONICALLY
SELECTING, ADDRESSING, AND DISTRIBUTING
MESSAGES
Serial No.: 09/545,088
Attorney Docket No.: CGH 3001

PAGES: INCLUDING COVER PAGE (10)

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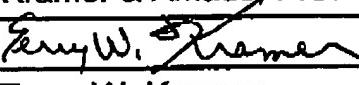
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Application Number	09/545,088
Filing Date	April 7, 2000
First Named Inventor	Charles G. Heisinger, Jr.
Art Unit	2162
Examiner Name	Jean B. Fleurantin
Attorney Docket Number	CGH 3001

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